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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,149	03/04/2002	Baokang Yang	19400/09014	5923
1095	7590	05/30/2006	EXAMINER BECKER, DREW E	
NOVARTIS CORPORATE INTELLECTUAL PROPERTY ONE HEALTH PLAZA 104/3 EAST HANOVER, NJ 07936-1080			ART UNIT 1761	PAPER NUMBER

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/091,149	YANG, BAOKANG	
	Examiner	Art Unit	
	Drew E. Becker	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 and 10-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1 recites "the protein source is a combination of whey protein isolate and whey protein hydrolysate", while dependent claim 10 recites "whey protein hydrolysate comprises **up to** 20 wt% of the combination", and dependent claim 23 recites "the protein source is whey protein isolate". It is not clear whether whey protein hydrolysate is required, or not.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8, 10-20, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liebrecht et al as applied above, in view of GB 2335134A.

Liebrecht et al teach a clear beverage (column 1, line 6) comprising up to 4% whey protein isolate (column 4, line 54), a carbohydrate content of 15-40% (column 10, line

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35), about 2% edible acid (column 4, line 55), 5-95% fruit juice (column 4, line 40), the beverage being clear (column 8, line 49), a PH of 4.0 or less (column 8, line 25), a viscosity of less than 15 cp (column 9, line 30), carbohydrates such as a blend of sucrose, fructose, and maltodextrin (column 8, line 12), acids such as a blend of malic, citric, and phosphoric (column 8, line 27), at least 33% the recommended daily intake of calcium (column 9, line 1), vitamins such as folic acid (column 8, line 56), an absence of arabinogalactan, less than 0.1% pectin (column 9, line 36), and the ratios of ingredients being varied within the overall range (column 10, line 21). Liebrecht et al do not recite the use of whey protein hydrolysate. GB 2335134A teaches the use of whey protein hydrolysate in a beverage (page 3, lines 17-25). It would have been obvious to one of ordinary skill in the art to incorporate the whey protein hydrolysate of GB 2335134A into the invention of Liebrecht et al since both are directed to fortified beverage compositions, since Liebrecht et al already included whey protein isolate (column 4, line 55), and since GB 2335134A teaches that whey protein hydrolysate had the advantage of being more easily digested (page 3, line 22).

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liebrecht et al, in view of GB 2335134A, as applied above, in view of JP 404311378A. Liebrecht et al and GB 2335134A teach the above mentioned components. Liebrecht et al and GB 2335134A do not recite about 0.5-4% inulin. JP 404311378A teaches a fruit juice beverage comprising 1-30% of a type of inulin (abstract). It would have been obvious to one of ordinary skill in the art to incorporate the inulin of JP 404311378A into the invention of Liebrecht et al, in view of GB 2335134A, since all are directed to

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beverage compositions, since Liebrecht et al already included supplemental carbohydrates (column 7, line 59), and since the inulin of JP 40431 1378A would have provided an added source of fiber (abstract).

Response to Arguments

7. Applicant's arguments filed 3/27/06 have been fully considered but they are not persuasive.

In response to applicant's argument that Liebrecht et al and GB 2335134A are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Liebrecht et al is directed to a nutritional beverage based on fruit juice, carbohydrate, and protein, while GB 2335134A is also directed to a nutritional beverage based on fruit juice, carbohydrate, and protein.

Applicant argues that the beverage of GB 2335134A would precipitate. However, GB 2335134A specifically states that they have solved this problem (page 3, line 28).

Applicant argues that the references do not recite a clear beverage. However, Liebrecht et al specifically disclose a clear beverage (column 1, line 7).

Conclusion

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8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E. Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Fri. 8am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


DREW BECKER
PRIMARY EXAMINER
5-26-06